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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,923	08/09/2001	Keiichi Imamura	2001-0555A	5080

EXAMINER
ROBINSON, BINTA M

ART UNIT	PAPER NUMBER
1625	

513 7590 07/14/2006
WENDEROTH, LIND & PONACK, L.L.P.
2033 K STREET N. W.
SUITE 800
WASHINGTON, DC 20006-1021

DATE MAILED: 07/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,923

Applicant(s)

IMAMURA ET AL.

Examiner

Binta M. Robinson

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8,10,12,13,16 and 29-35 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8,10,12,13,16 and 29-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/13/04;6/15/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Detailed Action

The 112, first paragraph rejection of the phrase "case where R1 is a hydrogen atom, A represents a bond or a methylene chain, R3 is phenyl or cyclohexyl", the 112, second paragraph rejections of claims 1-13, 16, 29-35, and the 102 (b) rejection of claims 1-13, 16, 29-35 over Ricks et. al., the 103 (a) rejection of claims 1, 3, 5, 7, 10, 13, and 35 over Carceller are rendered moot in light of applicant's comments and amendments filed 6/16/05.

(modified rejection)

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 3, 4, 5, 6, 7, 8, 10, 12, 13, 16, 29, 30, 31, 32, 33, 34, 35 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The provisos in claims 1, 2, 3, 4, 5, 6, 7, 8, 10, 12, 13, 16, 29, 30, 31, 32, 33, 34, 35 do not have proper antecedent basis in the specification. The proviso excluding the case wherein R1 is hydrogen, A is a bond or an alkylene chain, R3 is a hydrogen atom, and the case wherein R1 is a hydrogen atom, A is a bond, and R3 is an adamantly or a phenylalkyl is not supported anywhere in the specification.

(new rejection)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3, 5, 10, and 35 are rejected under 35 U.S.C. 102(b) as being by

Larger et. al..

Larger et. al. discloses compounds 7 and 8. Compound 7 anticipates claims 1,3, 5, 10, and 35 because A is a bond, R3 is phenyl maybe substituted with two methyl groups, R1 is hydrogen, and R2 methyl. Compound 8 anticipates claims 1,3,5, 10, and 35 because A is bond, R3 is phenyl maybe substituted with two isopropyl groups, R1 is hydrogen, and R2 methyl.

Response to Applicant's Remarks

The applicant's cite In re Johnson in support of their position that the provisos are not new matter. However, the MPEP at 2173.05 (i) states that any negative limitation or exclusionary proviso must have basis in the original disclosure, and these provisos do not. According to Ex parte Grasselli, a claim containing a negative limitation which does not have a basis in the original disclosure should be rejected under 35 U. S. C. 112, first paragraph as failing to comply with the written description requirement.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binta M. Robinson whose telephone number is (571) 272-0692. The examiner can normally be reached on M-F (9:30-6:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas McKenzie can be reached on 571-272-0670.

A facsimile center has been established. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier numbers for accessing the facsimile machine are (703)308-4242, (703)305-3592, and (703)305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571)-272-1600.



BMR
July 7, 2006



THURMAN K. PAGE
SUPERVISORY PATENT EXAMINER
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